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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,298	12/29/2000	Peter R. Gawthrop	10541/125	1456

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EXAMINER

LEO, LEONARD R

ART UNIT	PAPER NUMBER
3743	8

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/753,298

Applicant(s)

GAWTHROP ET AL. 

Examiner

Leonard R. Leo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2002 and 26 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 7-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION***Election/Restrictions***

Applicant's election with traverse of the invention of Group I and the species of Figure 4 in Paper No. 5 is acknowledged. The traversal is on the ground(s) that 1) applicants do not like the Examiner's example of the materially different process of using the product, and 2) there would be no search burden. This is not found persuasive because:

1) Applicants must be aware that the claims of the invention of Group I are apparatus claims merely reciting a device. The device itself can be employed in any working environment. By reciting a "downflow condenser" does not impart any patentability to the device. For example, a simple heat pump system comprises a compressor, evaporator, expansion device and condenser capable of operating in a cooling or heating mode. In cooling mode, heat is released by the working fluid through the outdoor unit (condenser) and heat is absorbed by the indoor unit (evaporator). In heating mode, heat is absorbed by the outdoor unit (evaporator) and heat is released by the indoor unit (condenser). Thus, the indoor and outdoor units can function in a condensing or evaporating mode depending on the requirements. The structure of the device does not go through a metamorphosis based on the different function. Another example which applicants may find valuable follows. If one were to build the exact same structural device defined by the apparatus claims and employ the device as an evaporator, would applicants invention be infringed? The Examiner thinks so. However, the method claims would not be infringed, since the method of operation is different.

2) First of all, the burden is decided by the Examiner, not applicants. The species are mutually exclusive and capable of supporting separate patents. If applicants do not believe the

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species are patentably distinct, then they should state for the record that the species are obvious variants of each other. Do applicants believe the only difference between the species of Figure 4 and 9 are the number of passes through the device? If this were the case, the Examiner would reconsider the election requirement.

The requirement is still deemed proper and is therefore made FINAL.

Applicant's election with traverse of the species of a "bypass baffle" in Paper No. 7 is acknowledged. The traversal is on the ground(s) that there would be no search burden. This is not found persuasive because as noted above in part 2).

The requirement is still deemed proper and is therefore made FINAL.

Claims 7-13 and 14-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species and invention, respectively, there being no allowable generic or linking claim. Regarding claim 20, although the claim is readable on Figure 4, the claim is believed to be a combination of the claimed species of the Markush group present in claim 3. Applicants have elected the claimed feature of only a "bypass baffle." Therefore, claim 20 is withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Benzinger.

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Claims 1-3 and 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Woodhull, Jr. et al.

In the rejections above, the recitation of horizontal manifolds, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Therefor, orienting the device of Benzinger 90 degrees clockwise will read exactly on the claim.

Claims 1-2 and 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Saperstein.

Claims 1-3 and 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Bhatti et al.

Claims 1-3 and 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Inaba et al (Figure 7).

In all rejections above, the "wherein" clause is considered to be functional language bearing no patentable weight in this instance. See MPEP 2114.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inaba et al in view of Burk et al.

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Inaba et al discloses all the claimed limitations except an internal dryer.

Burk et al discloses a condenser comprising a pair of opposed manifolds 13, 44 or 45; a plurality of tubes 11 and extended surfaces 12; and internal dryer 32 for the purpose of optimizing space requirements.

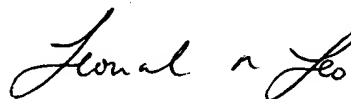
Since Inaba et al and Burk et al are both from the same field of endeavor and/or analogous art, the purpose disclosed by Burk et al would have been recognized in the pertinent art of Inaba et al.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ in Inaba et al an internal dryer for the purpose of optimizing space requirements as recognized by Burk et al.

Conclusion

Any inquiry of a general nature, relating to the status of this application or clerical nature (i.e. missing or incomplete references, missing or incomplete Office actions or forms) should be directed to the Technology Center 3700 Customer Service whose telephone number is (703) 306-5648. Status of the application may also be obtained from the Internet: <http://pair.uspto.gov/cgi-bin/final/home.pl>

Any inquiry concerning this Office action should be directed to Leonard R. Leo whose telephone number is (703) 308-2611.



LEONARD R. LEO
PRIMARY EXAMINER
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May 18, 2003